

REMARKS

In the Final Office Action mailed September 20, 2007, claims 1-38, 59-62 and 81-93 were pending and stood rejected. Reconsideration of the final rejection and allowance of the present application in view of the remarks herein are respectfully requested.

Claims 5-11, 20-27 and 83-88 were initially indicated as being rejected under 35 U.S.C. §112, second paragraph. See e.g., Final Office Action, page 2. However, the Final Office Action then goes on to indicate that the previous rejection under 35 U.S.C. §112, second paragraph has been withdrawn. See e.g., Final Office Action, page 7, lines 4-6. Applicants are currently responding under the presumption that these rejections have been withdrawn. Clarification with regard to the status of the rejections under 35 U.S.C. §112, second paragraph is respectfully requested.

Claims 1-14, 18, 20-22, 81-88, 92 and 93 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent App. Pub. No. 2003/0105462 to Haider. In regard to this rejection, Applicants previously submitted detailed arguments that traversed the rejection based on Haider and its lack of disclosure of several features recited in these claims. See the Office Action Response filed September 11, 2007.

The Final Office Action has not addressed Applicants' previous arguments. More particularly, the Office Action now provides, on page 7, lines 7-10:

The rejections of claims 1-14, 18, 20-22, 81-88, 92 and 93 are not overcome since an affidavit has not been provided. It is also noted that although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As an initial matter, Applicants previous response did not indicate that an affidavit under 37 CFR §1.131 was necessary in order to overcome the anticipation rejections in view of Haider. Instead, Applicants affirmatively preserved the right to file such an affidavit, while traversing the rejections in view of Haider because of its failure to disclose the limitations of claims 1-14, 18, 20-22, 81-88,

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92 and 93. In particular, Haider fails to disclose, *inter alia*, a “visualization opening” as that feature is claimed in each of independent claims 1, 20 and 81.

The Final Office Action seems to suggest that Applicants' previous response attempted to read limitations from Applicants' specification into the pending claims. However, it is respectfully submitted that no such attempts were made, nor is the holding of Van Geuns applicable to the prior arguments. In Van Geuns, the Court held that a patentee could not read an NMR limitation into a claim that was not expressly directed to NMR in order to define the meaning of “uniform magnetic field”. In re Van Geuns, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993). Applicants have not attempted to read any limitations into the pending claims from the specification of the subject application. Instead, Applicants note that the specification of Haider does not reveal any discussion or specific disclosure of the structure of the element that is located near the center of the plate. More particularly, it appears that the Examiner has assumed that this element extends through the plate but there is no explicit disclosure of this arrangement in Haider. From this lack of disclosure, and given the range of possibilities for the structure of the center element and the lack of specificity regarding the same, it is respectfully submitted that Haider does not disclose a “visualization opening” as claimed.

In Helifix Ltd. v. Blok-Lok, Ltd., (208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000)) the Court addressed the issue of whether elements of the claim not expressly described in a brochure would have been understood by those skilled in the art to have been described. The Court held that a publication which “does not expressly disclose in words” claim elements may “be anticipating if a person of ordinary skill in the art would understand” that the publication disclosed those elements. 208 F.3d at 1347, 54 USPQ2d at 1304. As applied to the instant case, Applicants respectfully submit that those skilled in the art would understand that the element that is located near the center of the plate could be a recess in the plate with a wall located at the posterior side of the plate. Accordingly, Applicants submit that Haider fails to disclose a visualization opening as recited in claims 1, 20 and 81 in a manner that sufficiently establishes an anticipation rejection.

Additionally, Haider also fails to disclose various additional features of both claims 20 and 81. For example, claim 20 recites “wherein said first and second members each include a first width between an outer side surface of said plate and an inner side wall of said visualization opening, said

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visualization opening including a second width between inner side walls of said first and second members, said second width being greater than the combined first width of said first and second members." A review of Haider reveals that it is completely silent as to the width of the center element of the plate and the members extending along the sides of the center element. Thus, there can be no disclosure that the center element includes a width that is greater than the combined width of the members on the sides of the center element. The Final Office Action has not addressed these distinctions, nor has it provided any explanation as to how these features are disclosed by Haider.

Moreover, claim 81 recites "wherein each of said connection portions includes a pair of openings each for receiving a bone anchor therethrough to attach said connection portion to the respective adjacent vertebrae and each of said connection portions includes a retaining device engageable to said plate to prevent said bone anchors in said pair of openings from backing out of said plate." For the reasons submitted in Applicants' previous response cited above, Haider also fails to disclose these features. The Final Office Action has not addressed these distinctions, nor has it provided any further explanation as to how these features are disclosed by Haider. As indicated in the September 11, 2007 response, dependent claims 9, 10, 87 and 88 also recite features that are not disclosed in Haider, and there is no indication of how Haider is considered to disclose these claims.

In view of the foregoing, Applicants submit that Haider fails to disclose all the elements of claims 1-14, 18, 20-22, 81-88, 92 and 93. Accordingly, Haider cannot anticipate these claims and withdrawal of this rejection is respectfully requested.

Claims 36-38 stand rejected under 35 USC §102(b) as anticipated by U.S. Patent No. 5,423,826 to Coates et al. The Final Office Action indicates that "the Examiner carefully considered the arguments presented in the response filed on May 7, 2007 and found them not persuasive." See, Office Action, page 7, line 13. It then cites the comments in the previous office action as addressing Applicants' arguments. Applicants note that the rejection of claims 36-38 as being anticipated by Coates et al. in the Office Action mailed July 19, 2007 is identical to the rejection of claims 36-38 as being anticipated by Coates et al. that is provided in the Final Office Action. Neither rejection addresses the distinctions between the subject matter of claim 36 and the disclosure of Coates et al. as previously submitted by Applicants. In particular, as previously established, Coates et al. fail to disclose "a guide mechanism along said actuating system including at least one guide member

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spaced proximally from said plate when said holding system is engaged to said plate and with said at least one guide member positioned relative to said plate to guide placement of a bone engaging fastener through said at least one hole" as recited in claim 36. When guide member 180 is positioned relative to the plate to guide placement of the bone engaging fastener, it is positioned in bore 27 of the plate. Figure 19 is an exploded view, and the guide member 180 shown therein is not shown in a position to guide placement of the bone engaging fastener since Coates et al. disclose that guide member is placed in the plate hole to guide placement of the bone engaging fasteners. See col. 13, lines 44-47. The Final Office Action has maintained this rejection without addressing Applicants' previous arguments or providing an explanation as to how Coates et al. discloses that guide 180 is spaced proximally from the plate when the holding system is engaged to said plate and the guide member is positioned relative to the plate to guide placement of a bone engaging fastener through the hole as recited in claim 36.

Accordingly, Applicants respectfully submit that Coates et al. fails to anticipate claim 36 and request withdrawal of this rejection. Claims 37-38 depend from claim 36 and are patentable for at least the reasons supporting the patentability of claim 36, as well as the additional reasons previously provided by Applicants Reply cited above.

Claims 23-27 stand rejected under 35 USC §103(a) as being unpatentable over Haider alone. The Final Office Action maintains this rejection despite Applicants providing various reasons for traversal in the previous response. Moreover, the Final Office Action does not address Applicants' previous arguments regarding this rejection. Likewise, Applicants respectfully request full consideration of these arguments and explanation as to the furtherance of this rejection. In the absence of such, Applicants respectfully submit that this rejection has been overcome by the arguments submitted in the Reply of September 11, 2007. In particular, the examiner has not articulated any reasoning with any rational underpinning why one of ordinary skill in the art would modify Haider to arrive claims 23-27. The Examiner asserts In re Aller renders claims 23-27 obvious since discovering the optimum or workable ranges involves only routine skill in the art. However, In re Aller requires that the general conditions be disclosed in the prior art. As discussed above, Haider does not necessarily disclose the central element is an opening. Furthermore, its silence as to the center element and to the members along the center element cannot disclose the

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general conditions in claims 23-27 that relate the claimed length to width ratios to maximize the size of the opening while providing the necessary structure for the plate to support the spinal column loading. Accordingly, a *prima facie* case for the §103 rejection of claims 23-27 over Haider alone has not been established, and withdrawal of this basis of the rejection of claims 23-27 is respectfully requested.

Claims 1-15, 18-27, 81-88, 92 and 93 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lyons et al. and Bono et al. either alone or in combination with other references. In response to the arguments submitted in the September 11, 2007, response, the Final Office Action asserts that "Applicants disclosure as originally filed states that the visualization openings 60 can take other shapes (paras [0056] and [0059]). Accordingly, there is no criticality to providing an hour glass shape to visualization openings 60." See Final Office Action, page 7, lines 19-22. Applicants note that the portions of the specification cited by the Final Office Action indicate that openings 60 may be configured differently in alternative embodiments. However, the portions of the specification which Applicants previously cited for providing advantages related to the claimed features of the opening are not specifically directed to these alternative configurations for openings 60. Instead, they are directed to advantages provided by the illustrated visualization opening 60. Paragraph [0057], for example, recites "[i]n the illustrated embodiment, visualization openings 60 . ." and then provides advantages resulting from the illustrated embodiment. Paragraph [0059] includes a similar approach. Moreover, the various other paragraphs provide advantages related to the illustrated configuration of openings 60. Therefore, it is submitted that the subject application teaches the criticality of providing a visualization opening in the form of opening 60. The fact that other inventions disclosed in the application may include openings with other shapes does not negate the advantages and criticality that are disclosed for the opening to the extent the shape of the opening is recited in claims 1-13, 20-27, 81-88, 92 and 93. Accordingly, withdrawal of the rejections of these claims under 35 U.S.C. §103(a) over Lyons et al. and Bono et al. either alone or in combination with other references is respectfully requested.

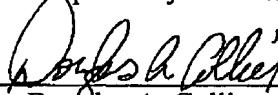
Claims 59-62 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bono et al. in view of Boucher et al. and separately, over Lyons et al. in view of Boucher et al. In response to the arguments submitted September 11, 2007, the Final Office Action asserts that "a

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person of ordinary skill in the art has good reason to use translucent material as taught by Boucher et al., as the material of construction for the Bono et al. plate or Lyons et al. plate, in order to obtain the predictable result of increased visibility of underlying bone." See, Office Action, page 7, lines 25-28. Even if the plate of either Bono et al. or Lyons et al. were modified according to the teachings of Boucher et al. in order to obtain increased visibility of the underlying bone, the combination of references fails to teach or suggest any intermediate portion of the plate that is comprised of a translucent material. Rather, Boucher et al. only teaches connection portions of the plates comprised of translucent material, whereas claim 59 specifies that it is the intermediate portion of the plate that extends between connection portions of the plate that are attachable to the adjacent vertebrae that is comprised of translucent material for visualizing the space between the adjacent vertebrae. Since the references fail to teach or suggest all the limitations in claim 59, claim 59 cannot be rendered obvious thereby. No reference has been cited that teaches the desirability of modifying portions of the plate that are not the portions attachable to the bone. Withdrawal of this rejection and allowance of claims 59-62 are respectfully requested.

In view of the foregoing remarks, it is respectfully submitted that examiner has failed to establish a *prima facie* case for rejecting the claims, and the application including claims 1-38, 59-62 and 81-93 is believed in condition for allowance. The examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

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